

REMARKS

We have amended dependent claim 14 to more particularly recite that the field-distorter is configured to not radiate an electro-magnetic field in response to the input signal. We submit that this amendment addresses the Examiner's § 112 second paragraph rejection.

With respect to the Examiner's drawing objection, we refer the Examiner to Figure 1, which shows an example of a field-distorter that is the subject of claim 14.

Prior Art Rejections

The Examiner rejected claims 1-20 and 22 as being unpatentable over Clark (U.S. 3,967,283) in view of Corman (U.S. 5,630,225). The Examiner acknowledges that Clark does not disclose a field distorter for influencing a first input signal but argues that Corman discloses this feature. The Examiner states that a field distorter is a known method for filtering out noise and/or distorted signals prior to being introduced into a mixer. It appears that the Examiner believes that it would have been obvious to one of ordinary skill in the art to modify Clark's field detector to use Corman's field distorter because it is relatively easy to install, implementable with any standard mixer and does not require a direct connection to the mixer. We disagree.

We submit that Clark and Corman, separately or in any proper combination, do not describe or suggest a detector device comprising at least a field-distorter, responsive to an input signal, for influencing at least one characteristic of a first electro-magnetic signal; and a mixer for combining at least the influenced first electro-magnetic signal and a second signal to produce a combined signal having a characteristic determined by the input signal, as recited in independent claim 1. We further submit that Clark and Corman do not disclose a motion detector device, as recited in claim 18, including a detector device having the features recited in claim 1. Finally, we submit that Clark and Corman do not disclose a method of operating a detector device comprising the steps of applying a signal to a circuit element to vary the electrical or electromagnetic characteristics of the circuit element and thereby influence at least one characteristic of the first electro-magnetic signal borne by a conductor and producing an

output signal indicative of the degree of influence exerted on the first electro-magnetic signal, as recited in independent claim 19.

In the first place, even if it were true that Corman's field distorter is relatively easy to install, implementable with any standard mixer and does not require a direct connection to the mixer, that hardly provides the rationale for why a person of skill in the art would have been prompted to combine the teachings of Clark and Corman to arrive at the claimed invention. The present rejection fits the court's description of what may not be done under § 103. The examiner must show where the prior art provides a motivation to combine the references he/she has combined in the obviousness rejection. Absent a motivation to combine, obviousness has not been demonstrated. As the Federal Circuit stated:

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990)

The Federal Circuit also stated:

The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. (*In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984, emphasis added).

In this case, the Examiner has pointed to nothing in the references themselves for why a person of ordinary skill in the art would have been motivated to combine the teachings of the references. Rather, the Examiner's rejection is a hindsight reconstruction, using applicant's claim as a template to reconstruct the invention by picking and choosing isolated disclosures from the prior art. This is impermissible under the law. For example, the Federal Circuit stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18

USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (*In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600)

We submit therefore that independent claims 1, 18, and 19 are patentable over Clark in view of Corman.

With respect to independent claims 1 and 18, we submit that that there are greater differences between Clark and the claimed invention than the Examiner acknowledges. For the sake of argument, even if a person of skill in the art would be motivated to combine the teachings of Clark and Corman in the manner proposed by the Examiner (which we vehemently deny), that person would still not arrive at the claimed invention. Specifically, Clark does not disclose a detector device (claim 1) or a motion detection system (claim 18) comprising a mixer for combining at least the influenced first electro-magnetic signal and a second signal to produce a combined signal having a characteristic determined by the input signal, as recited in independent claims 1 and 18. The Examiner points to element 100 of Clark as disclosing a mixer. But element 100 is an 8-bit shift register which is used to receive in parallel an 8-bit number and in response to clock signals from clock 90 provides in series the number to a 256 bit shift register 102. A shift register by any stretch of the imagination is not a mixer much less a mixer for combining at least the influenced first electro-magnetic signal and a second signal to produce a combined signal having a characteristic determined by the input signal. For this reason alone we submit that claims 1 and 18 are patentably distinct from Clark separately or in combination with Corman.

We submit that because claims 2-17 and 22 depend from independent claim 1 and claim 20 depends from independent claim 19, these dependent claims are patentable for at least the same reasons that claims 1 and 19 are patentable.

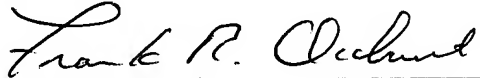
Applicant : Ian Richard Aldred
Serial No. : 10/039,280
Filed : January 2, 2002
Page : 9 of 9

Attorney's Docket No.: 13804-
002001 / HH/MC/P71774US

Enclosed is a Petition for One Month Extension of Time with a check for \$55.00 for the required fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: October 14, 2004



Frank R. Occhiuti
Reg. No. 35,306

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906